

### The 35 U.S.C. § 102(b) Rejections

Claims 1-22 and 24-30 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,819,857 to Inokuchi ("Inokuchi"). In view of the Applicant's remarks, reconsideration and withdrawal of the rejections are respectfully requested.

### The Present Invention

The present invention relates to a magnetic ink encoding system where an information signal is stored in the magnetic ink. In a magnetic ink system, a pen or other magnetic ink writing head may leave an ink substance upon a surface. The magnetic ink substance contains particles of a magnetic substance which are magnetized and can later be detected by a magnetic sensor. In an embodiment of the present invention, when ink is deposited upon a surface by a magnetic pen, the magnetic pen also magnetizes the ink with a time-varying magnetic field (e.g., specification page 4, line 32 – page 5, line 3).

Claim 1 is reproduced below for convenience.

1. An apparatus for storage of information, comprising:  
magnetic ink having a stored information signal.

In each of the five independent claims, claims 1, 5, 6, 20, and 24 of the present invention, the term "magnetic ink" is used.

### The Inokuchi Reference

Inokuchi describes an electromagnetic induction-type pattern input apparatus. The input apparatus includes what is referred to as "an electromagnetic pen" and a tablet including a plurality of conductors. Rather than a standard ink-writing instrument, the

"electromagnetic pen" is actually a rod with a coil wound up around the rod, wherein the rod is excited by a signal that may be produced by a gate pulse generator electrically connected to the rod. (Inokuchi; Figure 4, Abstract). Generally, the pen does not leave an ink deposit. (Inokuchi; Specification; Figure 7). The only mention of ink in Inokuchi does not mention the ink itself being magnetized or being capable of being magnetized. Rather, the sole purpose for the ink is to leave a residue visible to the naked human eye. (Inokuchi; Figure 9, col. 5, lines 53-60). No apparatus or method disclosed in Inokuchi leaves a magnetized ink deposit, or involves the use of magnetic ink.

### Argument

The Inokuchi reference fails to teach or suggest the apparatuses and methods disclosed for a magnetic ink encoding pen. In rejecting claim 1 and claims 2-4, which ultimately depend from independent claim 1, the office action states that Inokuchi discloses magnetic ink wherein information is stored. Although Inokuchi discloses a magnetic pen, none of the disclosure relied upon in the office action actually disclose magnetic ink technology. (Inokuchi; Figures 9-10, col. 6, lines 22-30; col. 7, lines 32-40; col. 3, lines 31-40; col. 6, lines 8-17). The only disclosed storage of information is provided for in the tablet, not in the ink. (Inokuchi; col. 6, lines 22-30). In the presently claimed invention, information is stored in the information signal in the ink.

In rejecting independent claim 5, the office action states that Inokuchi discloses a magnetic information storage structure including magnetic ink. The applicant respectfully disagrees. The citation relied upon in the office action does not disclose magnetic ink technologies; rather, it discloses gray-coding of electronic tablet outputs. (Inokuchi; col. 3, lines 64-67).

In rejecting claim 6 and claims 7- 19, which ultimately depend from independent claim 6, the office action states that Inokuchi discloses a magnetic ink encoding stylus that includes a penpoint adapted to apply magnetic ink. The applicant respectfully

disagrees. The disclosures of Inokuchi relied upon in the office action do not involve magnetic ink technology, rather they involve an electromagnetic pen which does not deposit magnetic ink. (Inokuchi; col. 9, lines 1-7; col. 3, lines 46-52; Abstract; col. 7, lines 49-56; col. 3, lines 53-60). As discussed above, the only ink disclosed in Inokuchi is not magnetized or capable of being magnetized, and its only purpose is for perception of the path of the stylus with the human eye.

The office action rejected the remaining claims on analogous grounds. Because all remaining claims ultimately depend upon the independent claims which recite the use of magnetic ink technology, the applicant respectfully requests that the rejection of those claims be reconsidered. Inokuchi does not involve or disclose any use of magnetic ink technologies. Accordingly, reconsideration and withdrawal of the rejection of claims 1, 5, 6, 20, and 24 and claims 2-4, 7-19, 21-23, and 25-30 which ultimately depend from claims 1, 6, 20, and 24, respectively under 35 U.S.C. § 102(b) is respectfully requested.

#### The 35 U.S.C. § 103(a) Rejection

Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Inokuchi in view of U.S. Patent No. 5,546,538 to Cobbley et. al. (“Cobbley”). Cobbley discloses a system for processing handwriting that is written on an electronic tablet. Like Inokuchi, Cobbley does not disclose any magnetic ink technology such as that recited in the pending claims. Because Cobbley does not make up for the deficiencies in Inokuchi described above, reconsideration and withdrawal of the rejection of claim 23 under 35 U.S.C. § 103(a) is respectfully requested.

## **CONCLUSION**

For all the above reasons, the Applicants respectfully submit that this application is now in condition for allowance. A Notice of Allowance is earnestly solicited.

The Examiner is invited to contact the undersigned at (408) 975-7500 to discuss any matter concerning this application. The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,  
KENYON & KENYON

Dated: 11/4/02

By:

  
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